

**REMARKS**

Claims 1 and 11 are amended. The amendments were made to Claims 1 and 11 to improve clarity and follow the language of Claim 37, as further described in the following section. Accordingly, Claims 1-59 remain pending. Applicants respectfully request reconsideration and allowance of all pending claims.

**Rejections Under 35 U.S.C. §112, first paragraph**

The Office rejected Claims 1 and 11 as not supported by the specification. The Applicant respectfully disagrees and believes that the Office has misinterpreted the Claims. However, to further expedite prosecution, the Applicant has amended Claims 1 and 11 to remove the double negative and follow the format of Claim 37, which was not rejected under §112, first paragraph. Accordingly, withdrawal of the rejection is respectfully requested.

**Rejections Under 35 U.S.C. §102**

Claims 1, 2, 8, 10-19, 25, 28, 36, 37, 39, 40, 43, 49 and 52 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,963,925 to Kolling et al. (herein after Kolling). The Applicant respectfully disagrees.

Claim 1, as amended, recites in part "wherein the recipient can be either a user or a non-user of a secure email system, wherein the non-user has not registered for a service of the secure email system". In contrast, Kolling discloses in FIG. 8, block 708 "consumer requests electronic statement subscription for a biller". Thus, it appears that Kolling's system requires consumers to, in effect, register for a service. Therefore, the Applicant respectfully asserts that Kolling does not disclose the above recited feature of Claim 1.

1 The Office asserts the following portions of Kolling in rejecting the recited  
2 feature of Claim 1:

3 It is important for a biller to deliver an invoice to a consumer  
4 so that the consumer may then pay the bill presented in the  
5 invoice. *Kolling, Col. 3, Lines 14-16.*

6 Although the present invention may operate stand-alone, in  
7 one embodiment of the invention the electronic statement  
8 presentment (ESP) system is an enhancement, or is  
9 complimentary to any suitable electronic bill payment system.  
10 In one specific embodiment, the ESP system is an  
11 enhancement to the electronic bill payment system described  
12 in U.S. Pat. No. 5,465,206, and in particular may be  
13 integrated with VISA's ePay system to provide full-circle  
14 electronic financial transactions for billers and consumers. By  
15 introducing electronic statement presentment to an existing  
16 electronic bill payment system, an added dimension enables  
17 fully automated bill payment. *Kolling, Col. 4, Lines 30-41.*

18 A bank or other consumer service provider may also integrate  
19 such an electronic statement delivery from a biller into its  
20 own electronic home banking product in order to enhance that  
21 product and to provide more value to its consumer. In this  
22 fashion, a consumer may continue a relationship with his  
23 current bank, yet still be able to receive electronic statements  
24 from any biller from which the consumer receives a service.  
25 Alternatively, a consumer may choose any consumer service  
provider it desires that might provide electronic statements by  
way of the present invention. Thus, the present invention  
enhances the value of the consumer financial institution or  
consumer service provider in the eyes of the consumer.  
*Kolling, Col. 5, Lines 17-29.*

The consumer financial institution may then use any of a  
variety of means to transmit this electronic statement to the  
consumer. For example, any electronic home banking service  
that the consumer financial institution supports may be used  
to transmit the electronic statement to the consumer.  
Electronic means such as the Internet, telephones, video  
telephones, televisions, WebTV, personal digital assistants, or

any other proprietary communication system may be used.  
*Kolling, Col. 5, Lines 42-50.*

To begin enrollment, in step 704 the CSP advertises biller availability in providing electronic statements to consumers. This advertisement may take place in any of a variety of media that the CSP uses to communicate with its customers such as over the Internet, electronic mail, regular mail, telephone, newspaper advertisements, etc. *Kolling, Col. 26, Lines 25-30.*

As shown in the above excerpted portions, however, Kolling merely describes integrating "the electronic statement presentment (ESP) system" with an "electronic bill payment system". Neither the above excerpted portions of Kolling, nor elsewhere in the Kolling reference, is there disclosure for "wherein the recipient can be either a user or a non-user of a secure email system, wherein the non-user has not registered for a service of the secure email system" as recited in Claim 1. Rather, Kolling describes that each user is enrolled in the system. See *Kolling, FIG. 8 and accompanying discussion at Col. 27, Lines 37-55.*

Further, Claim 1 recites "wherein the amount of bill data included in the email message is based, at least in part, on an email address of a recipient". The Office asserts the following portions of Kolling in rejecting this recited feature, which are excerpted as follows:

A CFI associated with each SGEN delivers each electronic statement to the appropriate customer using a customer identifier in the statement data and uses any chosen medium.  
*Kolling, Abstract.*

Whereas billers currently use an invoicing system to print statements on paper for mailing, the present invention is able to retrieve electronic statement data from invoicing system 204 for eventual generation of an electronic statement. Statement data 206 sent to biller 102 includes all of the data normally found in an invoice or a statement for a particular

consumer. In one specific embodiment, statement data 206 is transmitted in the form of a statement augmented record (SAR) when the data is sent from biller 102 to SORG 208 and includes the identifier and version of the template that the biller wishes to use in preparing an electronic statement for its customers. Typically, a biller will send a batch or billing round of statement data for numerous customers all at once, although statement data 206 may be sent for a single customer as well.

Template authoring workstation (TAWS) 210 is a computer that may be physically located at, or operated by, the biller, the BSP or the BFI. TAWS 210 utilizes current off-the-shelf authoring software packages and software described herein to create templates that contain the biller's processing instructions for displaying statements and invoices. A template contains the programmed instructions and graphic pattern for statement information to be presented to the consumer and is described in more detail below in FIG. 5.

*Kolling, Col. 9, Lines 34-55.*

Although the above excerpted portions describe "generation of an electronic statement", Kolling does not disclose "the amount of bill data included in the email message is based, at least in part, on an email address of a recipient" as recited in Claim 1. Indeed, there is no mention whatsoever of a relationship between an email address and an amount of bill data in Kolling. Rather, the Office asserts that "Kolling adjusts the amount of information to fit the medium". See *Office Action Dated January 27, 2005, Page 3*. It is respectfully submitted that this is not the recited feature.

Accordingly, for at least these reasons it is respectfully submitted that a *prima facie* case of anticipation has not been established with respect to Claim 1. Consequently, withdrawal of the rejection with respect to Claim 1 is respectfully requested.

1       **Claims 2, 8 and 10** depend either directly or indirectly from Claim 1 and  
2       are allowable as depending from an allowable base claim. These claims are also  
3       allowable for their own recited features which, in combination with those recited  
4       in Claim 1, are neither shown nor suggested in the references of record, either  
5       singly or in combination with one another.

6       **Claim 11**, as amended, recites in part “a financial transaction manager ...  
7       to manage access to and manipulation of financial account assets to effect  
8       requested financial transactions with any participant or non-participant, wherein  
9       the non-participants have not registered for a service of an email system supported  
10      by the email server”. The Office again asserts Kolling at Col. 33, Line 43 to Col.  
11      44, Line 33 (essentially 11 columns of the reference) as disclosing an email server  
12      having a storage medium and financial transaction manager. The Applicant  
13      respectfully disagrees.

14      Again, the Applicant has not been able to determine which component(s) in  
15      this very large amount of text correspond to an email server. As stated in the  
16      MPEP, the Examiner “ordinarily should reject each claim on all valid grounds  
17      available.” *M.P.E.P.* §707.07(g). Further, “[w]here a major technical rejection is  
18      proper, it should be stated with a full development of reasons rather than by a mere  
19      conclusion coupled with some stereotyped expression.” *Id.* Accordingly, the  
20      Applicant again respectfully requests a full development of the rejection.

21      Regardless, Kolling does not disclose, teach or suggest the above recited  
22      feature of Claim 11. As previously described in relation to Claim 1, Kolling  
23      merely describes integrating “the electronic statement presentment (ESP) system”  
24      with an “electronic bill payment system”. Neither the above excerpted portions of  
25      Kolling, nor elsewhere in the Kolling reference, is there disclosure for the recited

1 feature of Claim 11. Rather, Kolling describes that each user is enrolled in the  
2 system. *See Kolling, FIG. 8 and accompanying discussion at Col. 27, Lines 37-55.*

3 Accordingly, for at least these reasons it is respectfully submitted that a  
4 *prima facie* case of anticipation has not been established with respect to Claim 11.  
5 Consequently, withdrawal of the rejection with respect to Claim 11 is respectfully  
6 requested.

7 Claims 12-19, 25, 28 and 36 depend either directly or indirectly from  
8 Claim 11 and are allowable as depending from an allowable base claim. These  
9 claims are also allowable for their own recited features which, in combination with  
10 those recited in Claim 11, are neither shown nor suggested in the references of  
11 record, either singly or in combination with one another.

12 Claim 37 recites, in part, "a financial transaction manager ... to manage  
13 access to and control assets of user accounts in response to user interaction with  
14 the user interface to enable the user to conduct financial transactions with another  
15 user or non-user of the email system, wherein the non-user of the email system has  
16 not registered for a service of the email system". The Office asserts the following  
17 portion of Kolling in rejecting this feature:

18 Although the foregoing invention has been described in some  
19 detail for purposes of clarity of understanding, it will be  
20 apparent that certain changes and modifications may be  
21 practiced within the scope of the appended claims. For  
22 instance, the invention may be integrated with any suitable  
23 electronic bill payment system. The functionality of the  
24 coordinating entity, including the functionality of the TAWS,  
25 the SORG, the switch, the SGEN, the TVAL, etc., may be  
distributed throughout the ESP environment, and may be  
implemented on separate computers or the functionality may  
be combined on fewer computers. In particular, the  
functionality of the SORG, the switch and the SGEN may be  
implemented centrally on a single computer, or may be

1 implemented on separate computers. Furthermore, both the  
2 SORG and SGEN may be located remotely at a biller and  
3 CSP, respectively. Also, the central site switch may be  
4 implemented using various computers performing different  
5 aspects of the switch functionality. For example, one  
6 computer may assist with ESP system functionality, while  
7 another assists with an electronic bill payment system. In  
8 addition, any format of data from a biller can be used, and the  
9 invention is capable of producing statements in a variety of  
10 data formats, including PDF, EDI 810, HTML, etc.  
11 Furthermore, statements, invoices, account updates, bills, or  
12 information of any kind may be transmitted using the present  
invention from a biller to one of its customers. For  
presentation of the information to a customer, any of a variety  
of media may be used to transmit and display the information  
from a CSP to the customer. Therefore, the described  
embodiments should be taken as illustrative and not  
restrictive, and the invention should not be limited to the  
details given herein but should be defined by the following  
claims and their full scope of equivalents. *Kolling, Col. 34,*  
*Lines 35-67.*

13 As shown in the above excerpted portion, Kolling does not disclose, teach or  
14 suggest a "user" or "non-user". Indeed, the asserted portion does not even include  
15 the word "user". Rather, the asserted portion merely describes that the system of  
16 Kolling may be implemented on separate computers and that statements may be  
17 transmitted using a variety of media. Again, as previously stated in relation to  
18 Claims 1 and 11, Kolling merely describes integrating "the electronic statement  
19 presentment (ESP) system" with an "electronic bill payment system". Neither the  
20 above excerpted portions of Kolling, nor elsewhere in the Kolling reference, is  
21 there disclosure for the recited feature of Claim 37. Rather, Kolling describes that  
22 each user is enrolled in the system. *See Kolling, FIG. 8 and accompanying*  
23 *discussion at Col. 27, Lines 37-55.*

24 Accordingly, for at least these reasons it is respectfully submitted that a  
25 *prima facie* case of anticipation has not been established with respect to Claim 37.

1 Consequently, withdrawal of the rejection with respect to Claim 37 is respectfully  
2 requested.

3 Claims 39, 40, 43, 49 and 52 depend either directly or indirectly from  
4 Claim 37 and are allowable as depending from an allowable base claim. These  
5 claims are also allowable for their own recited features which, in combination with  
6 those recited in Claim 37, are neither shown nor suggested in the references of  
7 record, either singly or in combination with one another.

8  
9 **Rejections Under 35 U.S.C. §103**

10 Claims 3, 4-6, and 9 stand rejected under 35 U.S.C. §103(a) as unpatentable  
11 over Kolling in view of Blossman. The Applicant respectfully disagrees.

12 As discussed above, the Applicant believes that Claim 1 is patentable over  
13 Kolling. Blossman does not cure the defects of Kolling, namely with regard to non-  
14 users as described above for Claim 1. Thus, the combination of Kolling and  
15 Blossman does not teach every element of Claim 1 and, therefore does not make  
16 out a *prima facie* case of obviousness. As claims 3, 4-6 and 9 depend from claim 1,  
17 Applicants respectfully assert that these claims are patentable over the cited  
18 references for at least the same reasons that claim 1 is patentable.

19 Further, with regard to Claim 3, the Office acknowledges that Kolling does  
20 not disclose the feature, "wherein the email message includes an address of where  
21 the bill data can be confidentially viewed if the recipient is not a participant in a  
22 secure email network".

23 However, the Office then asserts Blossman (Col. 2, Lines 40-45) as  
24 disclosing this feature. The Applicant respectfully submits that the asserted  
25



1 section of Blossman does not teach or suggest "constructing the email message to  
2 include at least an address of where the bill data may be confidentially viewed if  
3 the recipient is a non-user of the secure email system" as recited in Claim 3. For  
4 convenience, the asserted portion of Blossman is reproduced below.

5           However, the full check image of the Simmons patent  
6 is not described as a pictorial image of the actual paper  
7 check and is illustrated as a printed line of text  
8 conveying the check number, date, amount, etc.  
9 Additionally, the Simmons patent discloses the use of  
10 electronic mail for the transmission of notifications  
11 regarding potential errors.

12 Although the above reproduced disclosure from Blossman does mention the use of  
13 electronic mail for notifications regarding errors, it does not disclose "an address  
14 of where the bill data can be confidentially viewed ..." as recited in Claim 3.

15 Therefore, the Applicant respectfully submits that the combination of  
16 Kolling and Blossman does not teach or suggest each and every element of Claim  
17 1, and consequently, does not make out a *prima facie* case of obviousness for this  
18 additional reason. As Claims 3, 4-6 and 9 depend from claim 1, the Applicant  
19 respectfully asserts that these claims are patentable over the cited references for at  
20 least this additional reason that claim 1 is patentable over the cited references.

21 Claims 26, 27, 38, 50, 51 and 59 stand rejected under 35 U.S.C. §103(a) as  
22 unpatentable over Kolling in view of U.S. Patent 6,629,081 (hereinafter Cornelius).  
23 The Applicant respectfully disagrees.

24 Claims 26 and 27 depend from claim 11, and claims 38, 50, 51 and 59  
25 depend from claim 37. As discussed above, claims 11 and 37 are distinguished  
from Kolling. Cornelius is cited as disclosing an electronic auction service, an  
electronic retail service, and an email system. However, such disclosures do not

1 overcome the deficiencies of Kolling with regard to Claims 11 and 37.  
2 Accordingly, the combination of Kolling and Cornelius do not teach or suggest  
3 each and every element of Claims 11 and 37 and, therefore, fail to make out a  
4 *prima facie* case of obviousness for claims 11 and 37. As each of Claims 26, 27,  
5 38, 50, 51 and 59 depend from Claim 11 or 37, these dependent claims are  
6 patentable over the cited references for at least the reasons that Claims 11 and 37  
7 are patentable over the cited references.

8 Claims 29, 31, 53 and 55 stand rejected under 35 U.S.C. §103(a) as  
9 unpatentable over Kolling in view of U.S. Patent 6,678,664 (hereinafter Ganesan).  
10 The Applicant respectfully disagrees.

11 Claims 29 and 31 depend from claim 11, and claims 53 and 55 depend from  
12 claim 37. As discussed above, Claims 11 and 37 are distinguished from Kolling.  
13 Ganesan is cited as disclosing "wherein the financial transaction manager  
14 determines whether to honor the participant's payment when the specified account  
15 has insufficient assets to cover the requested payment." Ganesan is also cited as  
16 disclosing "honoring a check if adequate prior credit arrangements are made."  
17 Ganesan is also cited as disclosing "wherein the financial transaction manager  
18 automatically accesses a line of credit associated with the participant to honor the  
19 payment when the specified account has insufficient assets to cover the requested  
20 payment."

21 However, such disclosures do not overcome the deficiencies of Kolling  
22 with regards to Claims 11 and 37. Accordingly, the combination of Kolling and  
23 Ganesan do not teach or suggest each and every element of Claims 11 and 37 and,  
24 therefore, fail to make out a *prima facie* case of obviousness for these independent  
25 claims. As each of Claims 29, 31, 53, and 55 depend from Claim 11 or 37, these

1 dependent claims are patentable over the cited references for at least the reasons  
2 that Claims 11 and 37 are patentable over the cited references.

3 Claim 32 stands rejected under 35 U.S.C. §103(a) as unpatentable over  
4 Kolling in view Ganesan and further in view of Blossman. The Applicant  
5 respectfully disagrees.

6 Claim 32 depends from Claim 11. As discussed above, Claim 11 is  
7 patentable over the combination of Kolling and Ganesan. Blossman is cited as  
8 disclosing, "wherein the financial transaction manager notifies the participant of  
9 the insufficient funds and that the line of credit has been accessed to honor the  
10 requested payment."

11 However, such a disclosure does not overcome the deficiencies of Kolling  
12 and Ganesan with regards to Claim 11. Accordingly, the combination of Kolling,  
13 Ganesan and Blossman do not teach or suggest each and every element of Claim  
14 11 and, therefore, fails to make out a *prima facie* case of obviousness for Claim  
15 11. As Claim 32 depends from Claim 11, Claim 32 is patentable over the cited  
16 references for at least the reasons that Claim 11 is patentable over the cited  
17 references.

18 Claim 30 stands rejected under 35 U.S.C. §103(a) as unpatentable over  
19 Kolling in view Ganesan and further in view of U.S. Patent 5,649,116 (hereinafter  
20 McCoy). The Applicant respectfully disagrees.

21 Claim 30 depends from claim 11. As discussed above, Claim 11 is  
22 patentable over the combination of Kolling and Ganesan. McCoy is cited as  
23 disclosing, "wherein the financial transaction manager utilizes a growing model to  
24 determine whether to honor the payment when the specified account has  
25 insufficient assets to cover the requested payment."

1        However, such a disclosure does not overcome the deficiencies of Kolling  
2        and Ganesan in regards to Claim 11. Accordingly, the combination of Kolling,  
3        Ganesan and McCoy do not teach or suggest each and every element of Claim 11  
4        and, therefore, fails to make out a *prima facie* case of obviousness for Claim 11.  
5        As Claim 30 depends from Claim 11, Claim 30 is patentable over the cited  
6        references for at least the reasons that Claim 11 is patentable over the cited  
7        references.

8        **Claim 54** stands rejected under 35 U.S.C. §103(a) as unpatentable over  
9        Kolling in view McCoy. The Applicant respectfully traverses the rejection.

10       Claim 54 depends from Claim 37. As discussed above, Claim 37 is  
11       patentable over Kolling. McCoy is cited as disclosing, "wherein the financial  
12       transaction manager utilizes a growing model to determine whether to honor the  
13       payment when the specified account has insufficient assets to cover the requested  
14       payment."

15       However, such a disclosure does not overcome the deficiencies of Kolling  
16       with regards to Claim 37. Accordingly, the combination of Kolling and McCoy  
17       do not teach or suggest each and every element of Claim 37 and, therefore, fails to  
18       make out a *prima facie* case of obviousness for Claim 37. As Claim 54 depends  
19       from Claim 37, Claim 54 is patentable over the cited references for at least the  
20       reasons that Claim 37 is patentable over the cited references.

21       **Claims 22, 23, 46 and 47** stand rejected under 35 U.S.C. §103(a) as  
22       unpatentable over Kolling in view of U.S. Patent 6,049,784 (hereinafter Weatherly).  
23       The Applicant respectfully disagrees.

24       Claims 22 and 23 depend from claim 11, and claims 46 and 47 depend from  
25       claim 37. As discussed above, claims 11 and 37 are distinguished from Kolling.

1 Weatherly is cited as disclosing "wherein the financial transaction manager  
2 selectively receives assets for deposit in an account of a participant." Weatherly is  
3 also cited as disclosing "wherein the assets are received from a brokerage at the  
4 request of the participant."

5 However, such disclosures do not overcome the deficiencies of Kolling in  
6 regards to Claims 11 and 37. Accordingly, the combination of Kolling and  
7 Weatherly do not teach or suggest each and every element of Claims 11 and 37  
8 and, therefore, fail to make out a *prima facie* case of obviousness for these  
9 independent claims. As each of Claims 22, 23, 46 and 47 depend from Claim 11  
10 or 37, these dependent claims are patentable over the cited references for at least  
11 the reasons that Claims 11 and 37 are patentable over the cited references.

12 Claim 7 stands rejected under 35 U.S.C. §103(a) as unpatentable over  
13 Kolling in view Blossman and further in view of Cornelius. The Applicant  
14 respectfully disagrees

15 Claim 7 depends from Claim 1. As discussed above, Claim 1 is patentable  
16 over the combination of Kolling and Blossman. Cornelius is cited as disclosing,  
17 "identifying a domain name from the email address; and cross referencing the  
18 identified domain name against a list of secure domain names to determine  
19 whether the recipient belongs to a secure email network."

20 Applicants respectfully assert that the cited portion of Cornelius does not  
21 teach or suggest identifying a domain name from an email address. Rather, the  
22 cited portion of Cornelius appears to be directed to the firewalls shown in  
23 FIGS. 37 and 38. As can be seen in FIGS. 37 and 38, the firewalls are directed to  
24 protecting web servers and not email servers.

1 Further, the cited portion of Cornelius does not mention email address;  
2 instead it lists "user names and passwords, Internet IP address or domain name."  
3 There is no indication of where the domain is obtained. Moreover, the disclosure  
4 of web servers in FIGS. 37 and 38 would indicate that the domain name is  
5 obtained from web address and not an email address. Therefore, the listing of  
6 multiple security techniques does not teach or suggest identifying a domain name  
7 from an email address.

8 However, assuming *for the sake of argument alone* that Cornelius does  
9 disclose identifying a domain name from an email address, such a disclosure does  
10 not overcome the deficiencies of Kolling and Blossman in rendering Claim 1  
11 obvious. Accordingly, the combination of Kolling, Blossman and Cornelius does  
12 not teach or suggest each and every element of Claim 1 and, therefore, fails to  
13 make out a *prima facie* case of obviousness for claim 1. As Claim 7 depends from  
14 Claim 1, Claim 7 is patentable over the cited references for at least the reasons that  
15 Claim 1 is patentable over the cited references.

16 **Claims 24 and 48** stand rejected under 35 U.S.C. §103(a) as unpatentable  
17 over Kolling in view Weatherly and further in view of U.S. Patent 6,401,079  
18 (hereinafter Kahn). The Applicant respectfully disagrees.

19 Claim 24 depends from Claim 11, and Claim 48 depends from Claim 37.  
20 As discussed above, Claims 11 and 37 are distinguished from Kolling combined  
21 with Weatherly. Kahn is cited as disclosing "wherein the assets are received from  
22 an employer as compensation to the participant."

23 However, such a disclosure does not overcome the deficiencies of Kolling  
24 combined with Weatherly with regard to Claims 11 and 37. Accordingly, the  
25 combination of Kolling, Weatherly and Kahn does not teach or suggest each and

1 every element of Claims 11 and 37 and, therefore, fails to make out a *prima facie*  
2 case of obviousness for these independent claims. As Claims 24 and 48  
3 respectively depend from Claims 11 and 37, these dependent claims are patentable  
4 over the cited references for at least the reasons that Claims 11 and 37 are  
5 patentable over the cited references.

6 Claims 20, 21, 44 and 45 stand rejected under 35 U.S.C. §103(a) as  
7 unpatentable over Kolling in view of U.S. Patent 5,983,200 (hereinafter Slotznick).  
8 The Applicant respectfully disagrees.

9 Claims 20 and 21 depend from Claim 11, and Claims 44 and 45 depend  
10 from Claim 37. As discussed above, Claims 11 and 37 are distinguished from  
11 Kolling. Slotznick is cited as disclosing "wherein the first participant does not  
12 have a prior knowledge of the second participant's account information, but  
13 identifies the second participant from a list of network participants, wherein the  
14 second participant is identified by one of a name, an alias, or an email address."

15 However, such disclosures do not overcome the deficiencies of Kolling in  
16 anticipating Claims 11 and 37. Accordingly, the combination of Kolling and  
17 Slotznick does not teach or suggest each and every element of Claims 11 and 37  
18 and, therefore, fails to make out a *prima facie* case of obviousness for these  
19 independent claims. As each of Claims 20, 21, 44 and 45 depend from Claim 11  
20 or 37, these dependent claims are patentable over the cited references for at least  
21 the reasons that Claims 11 and 37 are patentable over the cited references.

22 Claims 33, 41 and 46 stand rejected under 35 U.S.C. §103(a) as  
23 unpatentable over Kolling in view of Kahn. Applicants respectfully traverse.

24 Claim 33 depends from Claim 11, and Claims 41 and 46 depend from  
25 Claim 37. As discussed above, Claims 11 and 37 are distinguished from Kolling.

1 Kahn is cited as disclosing "wherein the financial transaction manager issues an  
2 instruction to have a check issued and sent to an address specified by the request,  
3 upon authorization of the participant where the participants are an employer, a  
4 payment service, the employer's bank, and the employee payee who can receive a  
5 paper check instead of an electronic payment which is authorized by the employer  
6 payer."

7 However, such disclosures do not overcome the deficiencies of Kolling in  
8 anticipating Claims 11 and 37. Accordingly, the combination of Kolling and Kahn  
9 does not teach or suggest each and every element of Claims 11 and 37 and,  
10 therefore, fails to make out a *prima facie* case of obviousness for these  
11 independent claims. As each of Claims 33, 41 and 46 depend from Claim 11 or  
12 37, these dependent claims are patentable over the cited references for at least the  
13 reasons that Claims 11 and 37 are patentable over the cited references.

14 Claims 34 and 57 stand rejected under 35 U.S.C. §103(a) as unpatentable  
15 over Kolling in view of Kahn and further in view of "Wells Fargo Online". The  
16 Applicant respectfully traverses the rejection.

17 Claim 34 depends from Claim 11, and Claim 57 depends from Claim 37.  
18 As discussed above, Claims 11 and 37 are distinguished from Kolling combined  
19 with Kahn. Wells Fargo Online is cited as disclosing "the inclusion of a URL  
20 where the recipient can establish an account."

21 However, such disclosures do not overcome the deficiencies of Kolling and  
22 Kahn with regard to Claims 11 and 37. Accordingly, the combination of Kolling,  
23 Kahn and Wells Fargo Online does not teach or suggest each and every element of  
24 Claims 11 and 37 and, therefore, fails to make out a *prima facie* case of  
25 obviousness for these independent claims. As Claims 34 and 57 respectively



1 depend from Claim 11 or 37, these dependent claims are patentable over the cited  
2 references for at least the reasons that Claims 11 and 37 are patentable over the  
3 cited references.

4 Claims 35, 42 and 58 stand rejected under 35 U.S.C. §103(a) as  
5 unpatentable over Kolling in view of Kahn and further in view of U.S. Patent No.  
6 6,442,529 (hereinafter Krishan). Applicants respectfully traverse.

7 Claim 35 depends from Claim 11, and Claims 42 and 58 depend from  
8 Claim 37. As discussed above, Claims 11 and 37 are patentable over Kolling  
9 combined with Kahn. Krishan is cited as disclosing "offering a free service  
10 product as an incentive for a prospect to try a service."

11 However, such a disclosure does not overcome the deficiencies of Kolling  
12 combined with Kahn in with regard Claims 11 and 37. Accordingly, the  
13 combination of Kolling, Kahn and Krishan does not teach or suggest each and  
14 every element of Claims 11 and 37 and, therefore, fails to make out a *prima facie*  
15 case of obviousness for these independent claims. As each of Claims 35, 42 and  
16 58 depend from Claim 11 or 37, these dependent claims are patentable over the  
17 cited references for at least the reasons that Claims 11 and 37 are patentable over  
18 the cited references.

## CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe all pending claims are allowable. Accordingly, a Notice of Allowability is respectfully requested.

**Respectfully Submitted,**

Dated: 4/8/5

By: William J. Breen III  
Reg. No. 45,313  
(509) 324-9256 x249